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REMARKS

Claim 84 is new. Thus, Claims 1-12, 14, 23-27, 37, 83 and 84, based on an electrosurgical probe as illustrated for example, in Fig. 16 B are pending.

By the Office Action:

- (i) Claim 1 and dependent Claims 2, 3, 6, 7, 8, 10, 11, 12, 23, 24, 37 and 83 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,280,441 ("Ryan");
- (ii) Dependent Claims 4, 5, 9, 14, 25, and 27 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ryan in view of U.S. Patent No. 5,891,134 ("Goble"); and
- (iii) Dependent Claims 24 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of U.S. Patent No. 4,832,048 (Cohen).

For the following reasons, the present claims are patentable over the prior art of record and, therefore, reconsideration and allowance is respectfully requested.

Re. The rejection of Claims 1, 2, 3, 6, 7, 8, 10, 11, 12, 23, 24, 37 and 83 under 35 U.S.C. § 102(e) as being anticipated by Ryan

As set forth in Claim 1 and as illustrated in Fig 16 B, the Applicant's claimed probe comprises a return electrode formed into a coil, the coil defining a lumen therethrough; and an active electrode disposed through the lumen and projecting distally beyond the coil, wherein both the active and return electrode are supported by the shaft distal end portion, and wherein the active electrode is insulated from the return electrode by a spacer.

Ryan does not teach the Applicant's claimed probe since Ryan does not teach a coiled return electrode having a lumen with an active electrode therethrough as set forth in Claim 1. On the contrary, as shown for example in Fig 1, Ryan teaches a device comprising an effector wherein the active and return electrode twisted together into a helix designed for penetrating tissue. Thus, since Ryan's electrodes are twisted around each other into a helix, there is no lumen formed by the return electrode, and thus Ryan's active electrode is not disposed in a lumen to project distally beyond a coil, as set forth in

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dependent Claims 2, 3, 6, 7, 8, 10, 11, 12, 23, 24, 37, 83 and 84, these claims are not anticipated by Ryan. Accordingly, withdrawal of this rejection and reconsideration of the claims is respectfully requested.

Re. The rejection of Claims 4, 5, 9, 14, 25, and 27 under 35 U.S.C. § 103 (a) as being unpatentable over Ryan in view of Goble

As discussed above, Ryan does not teach a probe that includes a return electrode formed into a coil, the coil defining a lumen therethrough; and an active electrode disposed through the lumen and projecting distally beyond the coil, wherein both the active and return electrode are supported by the shaft distal end portion, and wherein the active electrode is insulated from the return electrode by a space.

This failure by Ryan to teach the Applicant's Claim 1 is neither rectified nor suggested by any teaching in Goble. Consequently, the Applicant's Claim 1 and its dependent Claims 4, 5, 9, 14, 25, and 27 are not unpatentable under 35 U.S.C. § 103 (a) in view of Ryan and Goble. Consequently, withdrawal of this rejection, and reconsideration of the claims is respectfully requested.

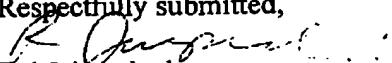
Re. The rejection of Claims 24 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Cohen

For the same reasons as set forth above with respect to Ryan and Goble, the Applicant's Claims 24 and 37 are not unpatentable under 35 U.S.C. § 103 (a) in view of Ryan and Cohen. Consequently, withdrawal of this rejection, and reconsideration of the claims is respectfully requested.

SUMMARY

It is believed that the claims are patentable over the art of record, and that the Application is in condition for allowance. Accordingly, reconsideration and allowance of the Application is respectfully requested. If any issue remains and a telephone conference would expedite prosecution of the Application, kindly telephone the undersigned at (408) 735-6486.

Respectfully submitted,


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